

ESTTA Tracking number: **ESTTA17332**

Filing date: **10/18/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
Party	Defendant Motorola, Inc. Motorola, Inc. 1303 East Algonquin Road Schaumburg, IL 60196
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Date	10/18/2004
Attachments	Answer 101804 F.pdf (5 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC.,

Opposer,

v.

MOTOROLA, INC.,

Applicant.

Opposition No.: 91161817

App. No.: 78/235,618

Mark: SENSORY MARK
(911 Hz tone)

ANSWER TO NOTICE OF OPPOSITION

Motorola, Inc. (“Applicant”) answers the Notice of Opposition as follows. For the Board’s convenience, each allegation in the Notice is set forth below and followed by Applicant’s answer thereto.

1. Opposer is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 12 million subscribers to its services nationwide.

ANSWER: Applicant admits that Opposer is one of the largest providers of cellular telephone services in the United States. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 1, and therefore, denies the allegations.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer for use with Opposer’s cellular telephone and dispatch services.

ANSWER: Applicant admits that it has a long-standing business relationship with Opposer. Applicant admits that it is a manufacturer of MOTOROLA phones and phone accessories that function on MOTOROLA network infrastructure operated by Opposer, and which

phones and accessories are sold to Opposer for resale to Opposer's cellular service customers. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 2, and therefore, denies the allegations.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

ANSWER: Applicant admits that it is a manufacturer of MOTOROLA phones and phone accessories that are sold to Opposer's direct competitors for resale to cellular service customers. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 3, and therefore, denies the allegations.

4. On April 9, 2003, Applicant filed an application for registration of an electronic sound consisting of a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on ("the 911 Hz Tone Application"). The 911 Hz Tone Application was assigned Serial No. 78/235,618, and was published for opposition in the Official Gazette on February 24, 2004. As published for opposition, the goods recited in the 911 Hz Tone Application are "[t]wo-way radios."

ANSWER: Applicant admits the allegations of paragraph 4.

5. The 911 Hz Tone Application was filed under Section 1(a) of the Lanham Act, and claimed May 6, 1991, as the date of first use and the date of first use in commerce.

ANSWER: Applicant admits the allegations of paragraph 5.

6. On October 17, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 911 Hz Tone Application, requiring a description of the 911 Hz tone and a specimen evidencing use of the 911 Hz tone in commerce.

ANSWER: Applicant admits the allegations of paragraph 6.

7. On October 17, 2003, Applicant submitted a response to the USPTO Office Action. The response included a description of the 911 Hz tone as follows: "[t]he mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON."

ANSWER: Applicant admits the allegations of paragraph 7.

8. Applicant's response to the USPTO Office Action also included a specimen of use in the form of a compact disc described as "[a] sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak." The specimen was asserted to have been in use in commerce since at least as early as the filing date of the application.

ANSWER: Applicant admits the allegations of paragraph 8.

9. Upon information and belief, Applicant has not used the 911 Hz tone in commerce in connection with the goods listed in the 911 Hz Tone Application, in derogation of Sections 1 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1127.

ANSWER: Applicant denies the allegations of paragraph 9.

10. Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1127.

ANSWER: Applicant denies the allegations of paragraph 10.

11. Opposers avers that, as it is a purchaser and potential purchaser of communications devices incorporating two-way radio capabilities from Applicant and other vendors of such devices, and as Opposer also sells such devices to end users, it will be damaged by the unjustified registration by application of the 911 Hz tone as set forth in the 911 Hz Tone Application.

ANSWER: Applicant denies the allegations of paragraph 11.

AFFIRMATIVE DEFENSE

OPPOSER IS ESTOPPED BY ACQUIESCENCE AND/OR LACHES

Opposer has long been aware of Applicant's adoption and use of the 911 Hz Tone mark but has failed to object to Applicant's adoption or use thereof, until the filing of the Notice of Opposition. During Opposer's unreasonable delay, Applicant's 911 Hz Tone mark, which is inherently distinctive, has acquired additional distinctiveness and has generated substantial goodwill for Applicant. Applicant has relied to its detriment on


Opposer's failure to object. Opposer's conduct constitutes estoppel by acquiescence and/or laches, thereby barring Opposer from obtaining any relief by its Notice.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed in its entirety with prejudice and that a registration issue to Applicant for its 911 Hz Tone mark.

Respectfully submitted,

MOTOROLA, INC.

Dated: October 18, 2004

By: 
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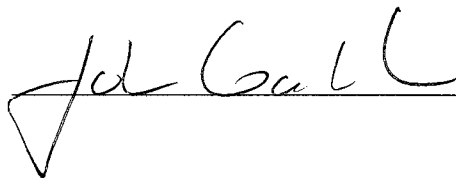
Attorneys for Applicant

Certificate of Service

The undersigned hereby certifies that a true and correct copy of the foregoing
ANSWER TO NOTICE OF OPPOSITION was served on Opposer's counsel by first class
mail, postage prepaid, addressed as follows:

John I. Stewart, Jr.
Crowell & Moring, LLP
P.O. Box 14300
Washington, D.C. 20004-4300

on October 18, 2004.



A handwritten signature, appearing to read "John I. Stewart, Jr.", is written over a horizontal line.